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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/508,516 06/08/00 BEBBINGTON

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EXAMINER

HM12/1012

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WOITACH, J

ART UNIT

PAPER NUMBER

1632

DATE MAILED:

10/12/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

File

**Office Action Summary**Application No.  
**09/508,516**Applicant(s)  
**Bebbington, C. et al.**Examiner  
**Joseph Weitach**Group Art Unit  
**1632**☒ Responsive to communication(s) filed on Jun 6, 2000☐ This action is **FINAL**.☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

**Disposition of Claims**☒ Claim(s) 1-26 and 28-42 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.☐ Claim(s) \_\_\_\_\_ is/are rejected.☐ Claim(s) \_\_\_\_\_ is/are objected to.☒ Claims 1-26 and 28-42 are subject to restriction or election requirement.**Application Papers**☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.☐ The specification is objected to by the Examiner.☐ The oath or declaration is objected to by the Examiner.**Priority under 35 U.S.C. § 119**☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been☐ received.☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).**Attachment(s)**☒ Notice of References Cited, PTO-892☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_☐ Interview Summary, PTO-413☐ Notice of Draftsperson's Patent Drawing Review, PTO-948☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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### **DETAILED ACTION**

This application is 371 National Stage filing of PCT/GB98/02867, filed 9/23/1998 which claims priority to the foreign application GB 9720465.5, filed 9/25/1997.

The preliminary amendment filed July 22, 2000, paper number 6 was received and entered. Claim 27 has been canceled. Claims 3-9, 12-18, 21, 23-26, 28-36, and 40-42 have been amended. Claims 1-26 and 28-42 are pending.

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-28, 30 and 42, drawn to a retroviral vector comprising gene sequences which comprise functional splice donor and acceptor sites in various orientations wherein expression of the gene results in a functional product and a method of transfecting cells with said vector.

Group II, claim(s) 29, 33-36, 40 and 41, drawn to a delivery system for a retroviral vector.

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Group III, claim(s) 31, drawn to a retroviral vector comprising an intron which can restrict expression of one or more nucleotide sequences of interest within a cell.

Group IV, claim(s)32, drawn to delivery of a retroviral vector by reverse transcriptase.

Group V, claim(s)37, drawn to a lentiviral vector system.

Group VI, claim(s)38, drawn to an adenoviral vector system.

Group VII, claim(s)39, drawn to vectors or plasmids based on or obtained from those listed in claim 39.

The inventions listed as Groups I-VII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

There is no special technical feature of the first invention of group I, claims 29, 33-36, 40 and 41, that is shared by the inventions of groups II-VII, considered as a whole which defines a contribution over the prior art. Independent claim 1 is broadly drawn to a retroviral vector comprising nucleotide sequence of interest wherein the sequence of interest has functional splice donor and acceptor sites which can be generated from a provirus. Morgenstern, J.P. *et al.* (NAR18:3587-3596, 1990) disclose provirus which has functional splice donor and acceptor sites encompassing the hygromycin gene. The vector has a SV40 origin and pBR Ori as well as U3 and U5 sequences of the Mo MuLV (for example, page 3589; Figure 2 and page 3590; Figure 3A). Thus, the retroviral vector recited in claim 1 is anticipated by Morgenstern *et al.* Since claim 1 does not contribute a special technical feature which defines a contribution over the

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previous art, the delivery system for a retroviral vector a retroviral vector comprising an intron which can restrict expression of one or more nucleotide sequences of interest within a cell, to delivery of a retroviral vector by reverse transcriptase, a lentiviral vector system, an adenoviral vector system, and vectors or plasmids based on or obtained from the vectors listed in claim 39 of Groups II-VII have been restricted because they encompass different inventions no longer linked by a special technical feature.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Woitach, whose telephone number is (703) 305-3732. The examiner can normally be reached on Monday through Friday from 8:00 to 4:30 (Eastern time).

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If attempts to reach the examine by telephone are unsuccessful, the examiner's supervisor, Karen M. Hauda, can be reached on (703) 305-6608. The fax number for group 1600 is 1(703)308-4242.

An inquiry of a general nature or relating to the status of the application should be directed to the group receptionist whose telephone number is (703) 308-0196.

Joseph T. Voitach

*Joseph T. Voitach*  
Patent Examiner  
AU 1632